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09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375

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EXAMINER	
HENNING, MATTHEW T	

ART UNIT	PAPER NUMBER
2431	

NOTIFICATION DATE	DELIVERY MODE
06/30/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	09/842,219	YAMAZAKI ET AL.	
	Examiner	Art Unit	
	MATTHEW T. HENNING	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,26,51,54-60 and 62-95* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,26,51,54-60 and 62-95* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This action is in response to the communication filed on 4/16/2009.

DETAILED ACTION

Response to Arguments

Applicants' arguments filed 4/13/2009 have been fully considered but the examiner does not find the arguments persuasive.

Regarding the applicants' argument that Li failed to disclose "checking...without a necessity of a communication between the portable communication device and the server", the examiner does not find the argument persuasive. The claim recites that the checking is performed without the need of communication between the portable communication device and the server. Paragraphs 117-120 of the instant specification states shows that the checking means receives the input biological information from a user, and compares it with stored biological information. In Li, these steps are performed inside the phone without communicating with the server. In this case, Li compares the captured fingerprint a previously received fingerprint which is stored in the phone. However, the comparison does not require any communication as the comparison is performed inside the phone. It is the storing of the reference fingerprint which requires communication between the portable communication device and the server, not the "checking". As such, the examiner does not find the argument persuasive. The examiner suggests that the applicants carefully review the claim language to ensure that the claims accurately reflect what they feel they have invented.

Regarding the applicants' argument that Li's process involves an exchange of data between a server and a client (the phone), and does not merely involve checking within the phone, the examiner does not find the argument persuasive. Again, Li's challenge-response is

not being equated to the checking alone, but rather the storing, checking, and transmitting steps are being equated with the challenge response portion of Li. However, as claimed, only the checking step requires no communication with the server. As discussed above, the checking, as claimed, is performed inside the phone, and no communication is required to perform the checking. As such, the examiner does not find the argument persuasive.

Regarding applicants' argument that Li failed to disclose the limitation that "[the] checking the read biological information with the stored biological information is carried out by using only the checking circuit in the portable communication device", the examiner does not find the argument persuasive. The checking, as claimed, has been interpreted as the comparison between the read and the stored biological information. In Li, this comparison is performed by the CPU 401, as can be seen in Col. 12 Lines 8-36 of Li. "FCPD 101 also includes a CPU (central processing unit) 401 that can supply...all processing of fingerprint images and their subsequent comparison". This is what reads on the checking and as such meets the limitations of the claim. As such, the examiner does not find the argument persuasive.

Regarding applicants' argument that Li did not disclose "sending personal identification number information to a server after transmitting information that fingerprint checking has matched to the server, the examiner does not find the argument persuasive. Clearly, once the checking has been performed at least one time in the past, the fingerprint activation described by Li in Col. 15 Lines 15-39 meets the claimed limitation of "after transmitting information that the checking has matched to the server, a personal identification number is sent to the server". As such, the examiner does not find the argument persuasive.

Regarding the applicants' argument that Li did not disclose permitting stored biological information at the server to be rewritten when the personal identification number matches a number stored at the server, the examiner does not find the argument persuasive. Li clearly discloses that the master user can authorize the changes at the server by validating it with his fingerprint, which is a form of a personal identification number. As discussed above, if the user has authenticated previously with the phone, at any point in time in the past, and then performs the authorization to add a fingerprint to the phone, the claim language has been met. Further, Li teaches that the master user can "at any time recruit additional users to be able to use their phone. By activating appropriate buttons on the phone, the master can in principle activate the phone and the CAS to receive a newly recruited user's fingerprint for association wit the master user's entry...The master can remotely authorize this action by simply validating it with his/her fingerprint". This clearly implies and renders obvious that the system has authenticated the master user in the past, and therefore sent an indication of a match to the server, when the recruited user's fingerprint is authorized to be stored in the server. Therefore, the examiner does not find the argument persuasive.

Claims 1, 26, 51, 54-60, and 62-95 have been examined. Claims 2-25, 27-50, 52-53, and 61 have been cancelled.

All objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 84-85, 93, and 95 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

Li disclosed a system for identifying an individual to identify a client, said system comprising: a storing means for storing the biological information of the client (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a reading means for reading the biological information of the client (See Li Fig. 4 Element 417); a checking means for checking the read biological information with the stored biological information without the necessity of a communication between the portable communication device and the server (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36); and a transmitting means for transmitting information to the server that the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), wherein checking the read biological information with the stored biological information is carried out by using only the portable communication device (See Li Col. 12 Lines 12-17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 92, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

Li disclosed providing a personal identification number to the phone (Li Col. 15 Lines 15-39) but failed to specifically disclose that in a case that the personal identification number matches with a number stored at the server the stored biological information can be rewritten.

However, it would have been obvious to the ordinary person skilled in the art that in the case that the master user's personal identification number information matched a number stored at the server that the stored biological information could be rewritten. This would have been obvious because the ordinary person skilled in the art would have been motivated to allow an authorized user (a user who's fingerprint matches the master users fingerprint) to update the biological information.

Claims 1, 26, 51, 54-60, 62-83, and 86-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li, and further in view of Nagayoshi et al. (US Patent Number 6,839,798) hereinafter referred to as Nagayoshi.

Regarding claims 1 and 26, Li disclosed a system for identifying a client (See Li Abstract), the system comprising a server and a portable communication device, wherein the portable communication device comprises: a memory for storing at least one reference biological information of the client using the portable communication device (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element 417); a checking circuit for checking the read biological information with the stored biological information without the necessity of a communication between the portable communication device and the server (See Li Fig. 4

Element 401 and Col. 12 Lines 8-36); and a transmitting circuit for transmitting information that the read biological information and the stored biological information have matched to the server in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), wherein the server is configured to transmit the information that the read biological information and the stored biological information have matched to a final end of transaction configured to start a transaction with the client conditioned upon receipt of the information that the read biological information and the stored biological information have matched (See Li Col. 16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

However, Li did disclose that the portable communication device could be a phone (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the fingerprint capturing device including program code for processing, as well as temporary data (See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling protocol to complete the connection" once the connection was authorized.

Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col. 1 Lines 6-18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the needed memory to Li in a small packaging area at a small cost.

Regarding claim 51, Li disclosed a business method using the Internet, said business method comprising: identifying a client by an identifying element loaded in a portable communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying comprises: storing a reference biological information of the client in a memory in the portable communication device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); reading biological information of the client (See Li. Col. 10 Lines 57-58); checking the read biological information with the reference biological information without the necessity of a communication between the portable communication device and the server (See Li Col. 10 Lines 61-65); and transmitting information that the read biological information and the reference biological information have matched from the identifying element to the control element in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), and wherein said controlling step comprises: admitting the communication between the client and the plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56), and wherein the server is configured to transmit the information that the read biological information and the stored biological information have matched to a final end of transaction configured to start a transaction with the client conditioned upon receipt of the information that the read biological information and the stored biological information have matched (See Li Col. 16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

However, Li did disclose that the portable communication device could be a phone (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the fingerprint capturing device including program code for processing, as well as temporary data (See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling protocol to complete the connection" once the connection was authorized.

Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col. 1 Lines 6-18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the needed memory to Li in a small packaging area at a small cost.

Regarding claim 83, Li disclosed a system for identifying a client, said system comprising: a server (See Li Fig. 1 Element 106); a storing means comprising memory for storing reference biological information of the client (See Li Fig. 4 Element 404); a reading means for reading biological information of the client (See Li Fig. 4 Element 101); a checking means for checking the read biological information with the reference biological information without the necessity of a communication between the portable communication device and the server (See Li Col. 10 Lines 61-65); a transmitting means for transmitting information that the

read biological information and the reference biological information have matched to the server in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9); a final end of transaction (See Li Fig. 3B Step 319 Recipient and Col. 16 Paragraph 2); a further transmitting means for transmitting said information that the read biological information and the reference biological information have matched from the server to the final end of transaction with the client (See Li Fig. 3B Step 319 and Col. 16 Paragraph 2); and a transaction starting means for starting a transaction between the client and the final end of transaction after the final end of transaction has received said information that the read biological information and the reference biological information have matched (See Li Fig. 3B Steps 316 and 319 and Col. 16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

However, Li did disclose that the portable communication device could be a phone (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the fingerprint capturing device including program code for processing, as well as temporary data (See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling protocol to complete the connection" once the connection was authorized.

Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col. 1 Lines 6-18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because

the ordinary person skilled in the art would have been motivated to provide the needed memory to Li in a small packaging area at a small cost.

Regarding claims 54 and 66, Li, and Nagayoshi, disclosed that the nonvolatile memory stores a plurality of biological information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10 Paragraph 4), and the transmitting circuit transmits information that the read biological information has matched with at least one of the stored plurality of information to the server (See Li Col. 11 Lines 3-9).

Regarding claims 55 and 67, Li, and Nagayoshi disclosed that the sensor reads a plurality of biological information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit transmits information that each of the plurality of read biological information has matched with at least one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

Regarding claims 56 and 68, Li, and Nagayoshi disclosed that the information that the read biological information and the stored biological information have matched is transmitted to the server through the Internet (See Li Col. 7 Paragraph 2).

Regarding claims 57 and 71, Li, and Nagayoshi disclosed that after transmitting information that the checking has matched to the server, a personal identification number information is sent to the Server (See Li Col. 15 Paragraphs 3-4).

Regarding claims 58 and 72, Li, and Nagayoshi disclosed that in a case that the personal identification number matches with a number stored at the server, the stored biological information is rewritable (See Li Col. 15 Paragraph 3).

Regarding claims 59-60, 73-74, and 78-79, Li, and Nagayoshi disclosed that the biological information is one selected from the group consisting of a fingerprint, a palm pattern

and a voice print; and that the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6 Paragraph 3 and Col. 17 Paragraph 3).

Regarding claim 62, Li, and Nagayoshi disclosed that the sensor includes one of a photodiode and a CCD (See Li Col. 4 Paragraph 6).

Regarding claims 63-65, 75-77, and 80-82, Li, and Nagayoshi disclosed that the portable communication device comprises a portable information terminal; a portable telephone; a personal computer (See Li Col. 5 Line 66 – Col. 6 Line 14).

Regarding claims 69-70, Li, and Nagayoshi disclosed a step of transmitting information that the checking has matched from the server to a connection of the client; and that a transaction is started between the client and the connection after the connection has received information that the checking has matched (See Li Col. 16 Paragraph 2).

Regarding claims 86, 87, 89, and 91, Li and Nagayoshi disclosed that checking the read biological information with the stored biological information is carried out by using only the checking circuit in the portable communication device (See Li Col. 12 Lines 12-17).

Regarding claims 88, and 90, see the rejection of claims 92 and 94 above.

Conclusion

Claims 1, 26, 51, 54-60, and 62-95 have been rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/
Examiner, Art Unit 2431